



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO..
10/055,364	01/23/2002	Clive Patience	61750-379	9994

7590 08/28/2003

CARELLA, BYRNE, BAIN, GILFILLAN,  
CECCHI, STEWART & OLSTEIN  
6 Becker Farm Road  
Roseland, NJ 07068

EXAMINER

FOLEY, SHANON A

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 08/28/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/055,364

Applicant(s)

PATIENCE, CLIVE

Examiner

Shanon Foley

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 and 12-14, drawn to an isolated polypeptide, classified in class 424, subclass 229.1.
- II. Claim 5, drawn to a method of making a polypeptide by expression from a recombinant cell, classified in class 435, subclasses 70.1 and 71.1.
- III. Claims 6-8, drawn to an antibody, classified in class 530, subclass 387.1.
- IV. Claim 9, drawn to a genetically engineered cell expressing an antibody, classified in class 435, subclass 339.
- V. Claim 10, drawn to a method of detecting the presence of porcine gamma-herpesvirus, classified in class 435, subclass 5.
- VI. Claim 11, drawn to a method of creating passive immunity by administering an antibody, classified in class 424, subclass 147.1.
- VII. Claim 15, drawn to a method of immunizing against porcine gamma-herpesvirus by administering an isolated polynucleotide, classified in class 424, subclass 229.1.
- VIII. Claim 16, drawn to a nucleic acid probe, classified in class 536, subclass 24.32. If applicant elects this group, applicant is also required to elect one of the nucleotide sequences selected from SEQ ID NOs: 25-36 recited in the claim. Applicant should note that the different sequences are not species.

Art Unit: 1648

- IX. Claim 17, drawn to a method of detecting gamma herpesvirus by detecting a polynucleotide that hybridizes, classified in class 435, subclass 5.

The inventions are distinct, each from the other because of the following reasons:

Inventions including SEQ ID NOs: 25-36 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are structurally distinct, as evidenced by a separately designated SEQ ID NO. Each is also functionally distinct because each probe is capable of hybridizing to a different sequence.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of group I can be made synthetically. In addition, the method can be used to make materially different polypeptides.

Inventions I, III, IV and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the polypeptide of group I and the antibody of group III are structurally and functionally distinct. Neither the polypeptide nor the antibody require the other for production or use. These products are also patentably distinct from the cell of group IV. The cell is also structurally and functionally distinct from the polypeptide of group I and the antibody of group III. The antibody

Art Unit: 1648

of group III can be made synthetically or induced in an animal model and does not require the genetically engineered cell for production. The nucleic acid probe of group VIII comprises nucleic acids while the polypeptide of group I and the antibody of group III comprise amino acids. Therefore, each of the products of groups I, III, IV and VIII are patentably distinct.

Inventions III and V, VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of group III can be used in materially different methods, such as detecting a polypeptide in the method of group V or in creating passive immunity in the method of group VI.

Inventions VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, group VI is drawn to creating passive immunity by administering an antibody and the method of group IX is drawn to a method of immunizing against a virus by administering a polynucleotide. These methods require different products to carry out the method and each have different effects on the immune system.

Inventions V and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to detecting different products of gamma herpesvirus. The method of

Art Unit: 1648

group V is drawn to detecting the presence of a polypeptide and the method of group IX is drawn to detecting a polynucleotide. Therefore, each of the methods require different products and method steps to accomplish the goals of each method.

Inventions VIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of detecting the presence of a polynucleotide can be practiced with different products, i.e. SEQ ID NOs: 25-36.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (703) 308-3983. The examiner can normally be reached on M-F 9:00-5:30.

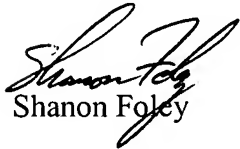
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 10/055,364

Page 6

Art Unit: 1648

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Shanon Foley

---